

**REMARKS**

Claims 2, 4, 6, 8, and 12-41 are pending in this application. In the July 21, 2005 Office Action, claims 2, 12-21, 34-37, and 42-56 were rejected and claims 6, 8, 22-33, and 38-41 were allowed.

In this response, claims 2, 4, 12, 19, 34-37, and 42-44 are amended, and claim 18 is cancelled. Reconsideration and allowance of claims 2, 4, 6, 8, 12-17, and 19-56 is respectfully requested in view of the following remarks.

**The Rejection of Claims 44 Under § 112:**

Claim 44 was rejected under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. Specifically, the Examiner stated that the specification does not enable any person to make and use an embodiment where the inside diameter of the compressible annular member is substantially equal to the inside diameter of the corresponding thin walled section. In response, claim 44 is amended to correct a typographical error. Claim 44 now recites that the inside diameter of the compressible annular member is substantially equal to the inside diameter of the corresponding *thick* walled section. The Applicant respectfully submits that claim 44, as amended, is fully enabled by the specification. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 44 was also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicant respectfully submits that the above-described amendments to claim 44 make claim 44 definite. Accordingly, withdrawal of this rejection is respectfully requested.

**The Rejection of Claims 4, 12-15, 18-21, 34-37, 42, 43, and 45 in view of Abdrakhmanov:**

Claims 2, 4, and 16-21 were rejected under 35 U.S.C. § 102(b) in view of Abdrakhmanov (US 5,083,608). The Applicant respectfully traverses.

Abdrakhmanov discloses an arrangement for patching off troublesome zones in a well that includes pipes (2) that are threaded together by an externally threaded end portion (3) that engages a corresponding internally threaded end portion (4) of an adjacent pipe (2). The inside diameters of the pipes (2) of Abdrakhmanov are always equal to one another.

Claim 4, as amended, recites A wellbore casing, comprising:

a first tubular member having a first inside diameter; and

a second tubular member having a second inside diameter equal to the first inside diameter coupled to the first tubular member in an overlapping relationship;

wherein the first and second tubular members are coupled by the process of deforming a portion of the second tubular member into contact with a portion of the first tubular member;

wherein, prior to the deformation, the inside diameters of the first and second tubular members are not equal;

wherein, prior to the deformation, the inside diameters of the first and second tubular members are substantially constant, **and**

**wherein a portion of the first tubular member overlaps with a portion of the second tubular member; wherein the portion of the first tubular member that overlaps with the portion of the second tubular member comprises a thin walled portion; and wherein the portion of the first tubular member that does not overlap with the portion of the second tubular member comprises a thick walled portion, and wherein the thin wall section is not threaded.**

Claim 4 has been amended to include the limitations in claim 18 and the limitation that the thin wall section is not threaded. Abdrakhmanov discloses pipes (2) that are threaded, and, therefore, it does not anticipate the invention claimed in amended claim 4. Dependent claims 18–21 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 12, 42, 43, and 44 have been likewise amended to include the limitation that the thin wall section is not threaded, and they are therefore, allowable over Abdrakhmanov. Dependent claims 13–15 and 45 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 34 has been amended to recite that the thin wall portion of the first tubular member comprises a first compressible sealing member, and the thin wall section of the second tubular member comprises a second tubular member. Claim 34, as amended, recites two separate compressible sealing members. Abdrakhmanov, on the other hand, discloses only a single sealing member (31). Thus, claim 34 is allowable over Abdrakhmanov. Claims 35–37 have been similarly amended and are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

**The Rejection of Claims 46–52 in view of Lohbeck:**

Claims 46–52 were rejected under 35 U.S.C. § 102(e) in view of Lohbeck (PCT WO 99/35368). The Applicant respectfully traverses.

Claim 46 recites a method of forming a wellbore casing that includes forming a first tubular member having a first portion comprising a first inside diameter and a second portion comprising a second inside diameter, wherein the second inside diameter is greater than the first. The claim also requires positioning a second tubular within and in overlapping relation to the second portion of the first tubular member, and expanding and plastically deforming the overlapping portion of the second tubular member into engagement with the second portion of the first tubular member. After the plastic deformation, the inside diameter of the plastically deformed overlapping portion of the second tubular member is equal to the inside diameter of the first portion of the first tubular member.

Lohbeck, on the other hand, discloses positioning the first tubular member (8) within the wellbore and then positioning a second tubular (9) so that they overlap. The “second casing 9 will further expand the first casing 8.” (Lohbeck, pg. 6, ll. 31–32). Thus, Lohbeck does not disclose positioning the second tubular within and in

overlapping relation to the second portion of the first tubular member because the first tubular member in Lohbeck does not include a second portion with a larger inside diameter.

Claim 46 is allowable over Lohbeck. Dependent claims 47–52 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

**The Rejection of Claims 2, 16, and 17 in view of Bailey and Abdrakhmanov:**

Claims 2, 16, and 17 were rejected under 35 U.S.C. § 103 over Bailey (US 5,957,195) in view of Abdrakhmanov. The Applicant respectfully traverses.

Bailey discloses a wellbore tool stroke indicator system and tubular patch that includes a corrugated tubular patch member 501 having an end portion 503 that overlaps with an end portion 504 of another corrugated tubular patch member 502. The inside diameters of the corrugated tubular patch members 501 and 502 are always substantially equal, and the inside diameters of the corrugated tubular patch members 501 and 502 are not constant.

Claim 2, as amended, includes the limitation that the thin wall section is adapted to radially expand and plastically deform from intimate contact with a thin wall section of a second tubular member upon radial expansion and plastic deformation of the second tubular member to form a mono-diameter wellbore.

**The Rejection of Claims 53–56 over Lohbeck in view of Bailey:**

Claims 53–56 were rejected under 35 U.S.C. § 103 over Lohbeck in view of Bailey. The Applicant respectfully traverses. Claims 53–56 depend from claim 46, which is allowable over Lohbeck because Lohbeck does not disclose positioning the second tubular within and in overlapping relation to the second portion of the first tubular member because the first tubular member in Lohbeck does not include a second portion with a larger inside diameter. Bailey does not make up for this deficiency.

Bailey discloses a patch (e.g., 500 in FIG. 10A) that is radially expanded in a pre-

existing tube. Bailey does not disclose positioning a second tubular member in an overlapping relation with the second portion of the first tubular member. Thus, claim 46 is allowable over the combination of Bailey and Lohbeck. Dependent claims 53–56 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Unless stated otherwise, none of the amendments to the claims were made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, the amendment to the claims were made to simply make express what had been implicit in the claims as originally worded and therefore is not a narrowing amendment that would create any type of prosecution history estoppel.

In addition, to the extent that formerly dependent claims have been amended to present them in independent form, such amendments do not limit the scope of the doctrine of equivalents for any of the elements of such amended claims. Rather, because dependent claims incorporate the limitations of the claims from which they depend, such amendments merely present the subject matter of the dependent claim in an equivalent form.

#### **The Information Disclosure Statements:**

The Applicant respectfully requests that the examiner consider the Information Disclosure Statements filed on September 10, 2003, May 12, 2005 and December 13, 2005.

#### **Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are drawn to novel subject matter, patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and allow claims presented for reconsideration herein. To the extent that the

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present amendment results in additional fees, the Applicant authorizes the Commissioner to charge deposit account no. 08-1394, order no. 25791.7.02.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,



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